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EXAMINER	
HANCE, ROBERT J	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,350	Applicant(s) SALKIND ET AL.	
	Examiner ROBERT HANCE	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: the term "the viewer" lacks proper antecedent basis. Appropriate correction is required.

1. Claim 24 is objected to because of the following informalities: Claim 24 reads "The apparatus of claim 1, further comprising . . .". However, claim 1 is a method claim, not an apparatus. Appropriate correction is required. For purposes of examination, it will be assume that claim 24 depends on claim 14.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claim 3 is rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 recites that "in the step of selecting and displaying one of the links, the information associated therewith is displayed." However, Claim 2, upon which Claim 3 depends, recites the same limitation in "selecting one of the links and displaying the information associated therewith". Claim 3 fails to further limit claim 2, and therefore does not meet the

requirements of 35 U.S.C. 112, fourth paragraph.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Independent Claim 1 recites the steps of a method that can be performed entirely manually. The claim recites associating links with video frames: this could be merely the step of writing URLs on a paper printout of a video image. Note that a "video frame" does not necessarily need to be displayed on a display device. The steps of selecting and banking the frames can be interpreted as selecting and storing (in a filing cabinet, for example) video printouts, while the step of selecting and displaying the frame can be performed manually by selecting and displaying (i.e. showing to others) a video printout. Dependent claims 2-13 can similarly be interpreted as being

performed manually and require no apparatus to be executed. Claim 11 recites transmitting data to at least one of a PDA, email address, cellular telephone, and a pocket PC. This step can be performed by a user manually typing and sending an email, for example.

Additionally, upon considering other weighing factors against eligibility, the claims are a mere statement of a general concept that is a basic human behavior of following instructions such as associating links with video frames, banking, storing, selecting and displaying those frames.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3, 12, 14, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Incentis, US Pub No. 2004/0133919.

As to claim 1 Incentis discloses a method of banking or storing video frames and their associated links, the method comprising the steps of:

a) associating multiple links with a video frame in a series of video frames, each of the links having information associated therewith ([0122]-[0127]; Fig. 8 – a plurality

hyperlinks are “alive” at a certain point in time of a program, therefore a video frame of the program is associated with multiple links);

b) selecting and banking the video frame from among the series of video frames ([0095] - video programs (made up of video frames) are recorded, therefore the frames of that program are selected (to be recorded) and banked in storage); and

c) selecting and displaying the frame in connection with representations of the links ([0095] – recorded programs, comprising video frames, are played back, therefore are selected and displayed. [0194]-[0198]; Figs. 20-23 – hyperlinks are displayed in connection with the reproduced content).

As to claim 2 Incentis discloses the method of claim 1, further comprising a step of selecting one of the links and displaying the information associated therewith (Figs. 22-24; [0196]-[0199] – hyperlinks are selected and a corresponding web page is displayed).

As to claim 3 Incentis discloses the method of claim 2, wherein in the step of selecting and displaying one of the links, the information associated therewith is displayed (Figs. 22-24; [0196]-[0199] – hyperlinks are selected and a corresponding web page is displayed).

As to claim 12 Incentis discloses the method of claim 1, further comprising a step of selecting one of the links and displaying the information associated therewith,

and a step of transmitting data in response to the selection to a remote location (Figs. 22-24; [0196]-[0199] – hyperlinks are selected and a corresponding web page is displayed. These web pages are sent from the server 2404 of Fig. 24 to the user device 2401, which is a location remote from the web server).

As to claim 14 Incentis discloses an apparatus for banking video frames associated with links, comprising:

a monitor for displaying video images from a series of video frames (Fig. 22);

a memory for storing the video images (Fig. 22: 2202; [0196]), and containing multiple links associated with a video frame in a series of video frames, each of the links having information associated therewith ([0122]-[0127]; Fig. 8 – a plurality hyperlinks are "alive" at a certain point in time of a program, therefore a video frame of the program is associated with multiple links);

a processor responsive to selection of a desired one or more of the video frames from among the series of video frames, and responsive to selecting a stored series of video frames and displaying at least one selected frame in connection with linking data for linking at least one of the selected frame and objects in the selected frame with additional data ([0095] – recorded programs, comprising video frames, are played back, therefore selected and displayed. [0194]-[0198]; Figs. 20-23 – hyperlinks are displayed in connection with the reproduced content).

As to claim 23 Incentis discloses the apparatus of claim 14, further comprising means for transmitting data in response to the selection to a remote location (Figs. 22-24; [0196]-[0199] – hyperlinks are selected and a corresponding web page is displayed. These web pages are sent from the server 2404 of Fig. 24 to the user device 2401, which is a location remote from the web server).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis in view of Walker et al., US Patent No. 6,263,505.

As to claim 4 Incentis fails to disclose the method of claim 1, further comprising a step of displaying the information in the form of an advertisement.

However, in an analogous art, Walker discloses displaying information related to a program in the form of an advertisement (col. 3 line 52 – col. 4 line 4; col. 4 line 63 – col. 5 line 5; col. 7 lines 48-52 – additional information related to purchasing an item in a program (i.e. an advertisement) is selected and displayed).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Walker, the motivation being to increase advertising revenue (see Walker col. 4 lines 1-4).

4. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis and Walker as applied to claim 4 above, and further in view of Yamamoto, US Patent No. 7,302,696.

As to claim 5 the combined system of Incentis and Walker fails to disclose the method of claim 4, further comprising a step of selecting the advertisement, and subsequently receiving credit for such selection in a viewer's account with a merchant.

However, in an analogous art, Yamamoto discloses selecting an advertisement, and subsequently receiving credit for such selection in a viewer's account with a merchant (Figs. 5 and 8; col. 7 line 64 – col. 8 line 27 – upon selection of an advertisement, a user can save a coupon to an account "My Coupons". These coupons are credit, with a merchant, in a viewer's account).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis and Walker with the teachings of Yamamoto, the rationale being to entice users to click on advertisements.

As to claim 6 the combined system of Incentis, Walker, and Yamamoto, as applied to claim 5 above, discloses the method of claim 4, further comprising a step of

selecting the advertisement, and subsequently receiving credit for such selection in a viewer's account with a merchant in the form of an electronic coupon (Yamamoto Figs. 5 and 8; col. 7 line 64 – col. 8 line 27).

5. Claims 7-8, 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis.

As to claims 7 and 8 Incentis fails to disclose the method of claim 1, further comprising a step of displaying the information in the form of a first item of information, wherein selecting the first item of information provides a first level of detail of information and a display to select a second item of information providing a second level of detail of information greater than the first level; and further comprising a step of providing a display for a third item of information providing a third level of detail of information greater than the second level.

However, Examiner takes official notice that these steps were well known in the art at the time of the invention. For example, given a web page (such as the one disclosed in [0199] and Fig. 24 of Incentis), it was well known to be able to “drill down” by selecting links within that web page and retrieve information at greater and greater (i.e. second and third) levels of detail. Therefore it would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis by enabling selection of second and third items for display of second and third levels of detail, the rationale

being to enable users who are interested to obtain more information, without displaying an overwhelming amount of information at a first level of detail.

As to claims 11 and 22 Incentis discloses a step of selecting one of the links and displaying the information associated therewith, and a step of transmitting data in response to the selection to a user device (Figs. 22-24; [0196]-[0199] – hyperlinks are selected and a corresponding web page is displayed on user device 2401).

Incentis fails to disclose that the user device is at least one of a PDA, email address, cellular telephone and a pocket PC.

However, Examiner takes official notice that a PDA was well known in the art at the time of the invention. For example, PDAs which were able to access the Internet were available and widely used at the time the invention was made. Therefore it would have been obvious to a skilled artisan at that time to modify the system of Incentis by replacing the user device 2401 of Fig. 24 with a PDA, the rationale being to enable the system to function on widely-available hardware with a large user base.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis in view of Yuen, US Patent No. 5,898,919.

As to claim 9 Incentis fails to disclose the method of claim 1, further comprising a step of displaying the information in the form of an opportunity to purchase at least one of goods and services.

However, in an analogous art, Yuen discloses displaying program related information in the form of an opportunity to purchase at least one of goods and services (col. 2 lines 23-43; col. 11 line 66 – col. 12 line 21; Fig. 6).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Yuen, the rationale being to increased convenience to the user by enabling impulse purchasing of advertised items.

7. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis in view of Hoshi et al., US Pub No. 2002/0083043.

As to claim 10 Incentis fails to disclose the method of claim 1, further comprising a step of storing a record of data relating to the viewer's selections of frames and of the viewer's selections from the stored frames, and transmitting the data to a source remote from the viewer.

However, in an analogous art, Hoshi discloses logging all operations of a television and video recorder, and transmitting the data to a source remote from the viewer ([0066]; [0257]-[0258] – operation history of VCR is recorded and sent to service section 9, therefore data relating to viewer’s selection of frames (i.e. programs a viewer has recorded) and a viewer’s selection of stored frames (i.e. playback of recorded programs) is recorded).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Hoshi, the motivation being to provide highly accurate audience ratings data (see Hoshi [0067]).

As to claim 21 Incentis fails to disclose the apparatus of claim 14, further comprising means for storing a record of data relating to the user's selections of frames and the user's selections from the stored frames, and for transmitting the data to a source remote from the viewer.

However, in an analogous art, Hoshi discloses logging all operations of a television and video recorder, and transmitting the data to a source remote from the viewer ([0066]; [0257]-[0258] – operation history of VCR is recorded and sent to service section 9, therefore data relating to viewer's selection of frames (i.e. programs a viewer has recorded) and a viewer's selection of stored frames (i.e. playback of recorded programs) is recorded).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Hoshi, the motivation being to provide highly accurate audience ratings data (see Hoshi [0067]).

8. Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis in view of Shastri et al., US Pub No. 2001/0003214.

As to claim 13 Incentis fails to disclose the method of claim 1, further comprising a step of displaying a thumbnail image of multiple selected and stored frames in conjunction with displaying a selected one of the thumbnail images as a larger image than the thumbnail images at the same time, and also displaying at least one advertisement at the same time.

However, in an analogous art, Shastri discloses displaying a thumbnail image of multiple selected frames in conjunction with displaying a selected one of the thumbnail images as a larger image than the thumbnail images at the same time, and also displaying at least one advertisement at the same time (Fig. 4; [0045]-[0048] – Fig. 4 shows a large, currently-selected thumbnail 201, as well as small thumbnails 202 from the program. Advertisements are concurrently shown, such as the “Powered by Innovatv” logo at bottom right, and the “Road Runner High Speed Online” at top right).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Shastri by displaying thumbnails of content in a recorded program (stored frames) alongside the content currently being viewed, the rationale being to enable fast and simple navigation within a program.

As to claim 24 Incentis fails to disclose the apparatus of claim 14, further comprising a display which displays a thumbnail image of multiple selected and stored frames in conjunction with displaying a selected one of the thumbnail images as a larger image than the thumbnail images at the same time, and also displaying at least one advertisement at the same time.

However, in an analogous art, Shastri discloses displaying a thumbnail image of multiple selected frames in conjunction with displaying a selected one of the thumbnail images as a larger image than the thumbnail images at the same time, and also displaying at least one advertisement at the same time (Fig. 4; [0045]-[0048] – Fig. 4 shows a large, currently-selected thumbnail 201, as well as small thumbnails 202 from the program. Advertisements are concurrently shown, such as the "Powered by Innovatv" logo at bottom right, and the "Road Runner High Speed Online" at top right).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Shastri by displaying thumbnails of content in a recorded program (stored frames) alongside the content currently being viewed, the rationale being to enable fast and simple navigation within a program.

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis in view of Pack et al., US Pub No. 2001/0052133.

As to claim 15 Incentis fails to disclose the apparatus of claim 14, wherein the monitor is for displaying television video, and for displaying the links in conjunction with the associated frame.

However, in an analogous art, Pack discloses displaying both television video and links to related information on the same monitor (Fig. 6; [0053]).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis with the teachings of Pack by integrating the functionality

of the user device of Incentis into the monitor. The rationale for this modification would have been to enable users to use the system of Incentis without a second user device, thereby increasing user convenience.

As to claim 16 the combined system of Incentis and Pack discloses the apparatus of claim 15, wherein the controller is adapted for displaying the information associated with the links on the monitor at the same as the links (Pack Fig. 6).

As to claim 17 the combined system of Incentis and Pack discloses the apparatus of claim 16, wherein the monitor is adapted for displaying the information in the form of at least one advertisement (Pack Fig. 6; [0053] – information about products is displayed, therefore the product is being advertised).

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incentis and Pack as applied to claim 17 above, and further in view of Yamamoto.

As to claim 18 the combined system of Incentis and Pack fails to disclose the apparatus of claim 17, wherein in response to selection of the advertisement, the apparatus sends a signal selecting a credit for such selection in a viewer's account with a merchant.

However, in an analogous art, Yamamoto discloses selecting an advertisement, and subsequently receiving credit for such selection in a viewer's account with a

merchant (Figs. 5 and 8; col. 7 line 64 – col. 8 line 27 – upon selection of an advertisement, a user can save a coupon to an account “My Coupons”. These coupons are credit, with a merchant, in a viewer’s account).

It would have been obvious to a skilled artisan at the time of the invention to modify the system of Incentis and Pack with the teachings of Yamamoto, the rationale being to entice users to click on advertisements.

As to claim 19 the combined system of Incentis, Pack, and Yamamoto, as applied to claim 18 above, discloses the apparatus of claim 17, wherein in response to selecting the advertisement, and subsequently receiving credit for such selection in a viewer's account with a merchant in the form of an electronic coupon (Yamamoto Figs. 5 and 8; col. 7 line 64 – col. 8 line 27).

As to claim 20 the combined system of Incentis, Pack, and Yamamoto, as applied to claim 18 above, discloses the apparatus of claim 17, further comprising links comprising an opt in for a coupon (Yamamoto Figs. 5 and 8; col. 7 line 64 – col. 8 line 27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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